

REMARKS

Reconsideration of the application as amended is requested.

Claim 1 has been amended to recite that the support member is slidably coupled to an armrest base member for movement along a path in first and second directions between first and second positions. Claim 1 further recites that "the bias moves the support member along the path from the second position to the first position even if no force is applied to the support member by a user".

Applicants respectfully assert that Tsai '775 does not disclose the arrangement of amended claim 1 either explicitly or inherently. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" MPEP 2112, citing *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

Applicants have carefully reviewed Tsai '775, and can find no disclosure indicating that the springs 45 cause the armrest to move. Rather, Tsai '775 states that,

When the office chair armrest of the present invention is to be adjusted forwards or backwards, referring to FIG. 5, it is only necessary to force the office chair armrest to move forward or backward . . . by which the engagement blocks 47 . . . are forced to be shrunk into the depressions 44 of the locating seat 4 to be in a compressed status until the engagement blocks 47 are respectively forced to slide into and urged to engage in any required ones of the two pluralities of engagement grooves 32.

Accordingly, Tsai '775 itself states that it is necessary to force the armrest forward or backward. Clearly, this is directly contrary to the arrangement of amended claim 1. Claims 2-13 depend from amended claim 1, and are therefore believed to be allowable for those reasons set forth above in connection with amended claim 1.

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Independent claim 21 has not been amended. Applicants point out that claim 21 recites armrests "including a device selectively retaining the armrest in the rearward position, wherein movement of the armrests releases the device such that the armrests move to the forward position due to the bias." Applicants reiterate that Tsai '775 teaches that it is "necessary to force the office chair armrest to move forward or backward". Thus, Tsai '775 is directly contrary to the arrangement of claim 21. "A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." MPEP 2173.05(g). Applicants respectfully request that the Examiner consider the invention as a whole, including all functional limitations. See also MPEP 2141.02(I). ("The claimed invention as a whole must be considered"). Applicants respectfully assert that it is improper to ignore certain features of claim 21, particularly when these features distinguish claim 21 from the prior art.

Claims 22-29 depend from claim 21, and are therefore believed to be allowable for those reasons set forth above in connection with claim 21.

Independent claim 31 has also not been amended. Applicants respectfully assert that it would not be obvious to modify Tsai '775 to include the mechanism of Bivens U.S. Patent No. 5,498,039. Specifically, if the spring loaded latch assembly of Bivens '039 were added to the Tsai '775 armrest, it is not at all clear that the spring 32 of Bivens '039 would provide sufficient force to overcome the retaining force of the engagement blocks 47 and springs 45 of Tsai '775. Bivens '039 is designed to move "between a closed or retracted position and an open or extended position upon impressing successive pushing forces upon the movable member" (column 1, lines 9-13). This is a completely different type of operation than the forced motion of Tsai '775 wherein an armrest is retained at any one of a number of positions after it is forced forwards or backwards by a user. Modifying Tsai '775 to include the Bivens '039 mechanism would therefore change the principle of operation of Tsai '775. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP 2143.01, citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

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Applicants further assert that the Examiner's purported motivation to combine Tsai '775 and Bivens '039 does not appear in the prior art itself. The Office Action of April 18, 2007 states that,

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Tsai by using a heart-pawl device to interconnect the armrests to the frame in order to allow the user to quickly return the armrests to its forward position.

The Office Action also states that "Tsai teaches . . . armrests [that] biased (by springs A - the springs push ball 47 into the detent slot, thereby biasing the support member into the first position) into the forward position." Thus, the hypothetical combination of Tsai and Bivens apparently contemplates that the 45 detents formed by the springs, engagement blocks 47, and grooves 32 of Tsai would remain in the hypothetical modified armrest. There is simply no rational reason to combine Tsai '775 with Bivens '039 to provide an armrest having both detents to retain the armrest and a push-push device. As stated by the United States Supreme Court, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness". *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). Applicants respectfully assert that a hypothetical "advantage" that is not taught by the prior art.

Claims 32-35 depend from claim 31, and are therefore believed to be allowable for those reasons set forth above in connection with claim 31.

New claim 36 is somewhat similar to original claim 1, and recites an armrest having a support member that is movable between forward and rearward positions. The armrest includes a device selectively retaining the support member in the rearward position. The device includes a catch and a movable retaining member that is engagable with the catch to retain the support member in the rearward position, wherein the retaining member prevents movement of the support member in the forward direction when the retaining member engages the catch, such that the support member cannot be moved in the forward direction when the retaining member engages the catch. In contrast to the arrangement of new claim 36, the detents of Tsai '775 do not prevent movement of the armrest in fore or aft directions. Rather,

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as discussed above, Tsai '775 teaches that the armrest can be moved forward or backward by a user despite the engagement of the engagement blocks 47 in grooves 32.

Claims 37-39 depend from claim 36, and are therefore believed to be allowable for those reasons set forth above in connection with claim 36.

New claim 40 is somewhat similar to original claim 1, and recites an armrest including an energy-storing member generating a biasing force that biases a support member into a first position "when the support member is positioned at a rearward position". The armrest of claim 40 further includes a device selectively retaining the support member in the rearward position. The device includes a catch and a movable retaining member that engages the catch and generates a force opposing the biasing force to retain the support member in the second position. Applicants respectfully assert that Tsai '775 does not disclose or suggest any such arrangement.

Claims 41-44 depend from claim 40, and are therefore believed to be allowable for those reasons set forth above in connection with claim 40.

New claim 45 is somewhat similar to new claim 40, and recites that the support member is biased into the first position when in the second position. Applicants respectfully assert that the cited references do not disclose any such arrangement.

Claims 46-48 depend from claim 45, and are therefore believed to be allowable for those reasons set forth above in connection with claim 45.

Applicants have made a concerted effort to place the present application in condition for allowance, and a notice to this effect is earnestly solicited. In the event there are any remaining informalities, the courtesy of a telephone call to the undersigned attorney would be appreciated.

Respectfully submitted,

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